APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,180	04/01/1998	BRIAN J. REISTAD	06543035001	2217

24573 7590 12/29/2005	EXAMINER
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ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/054,180	REISTAD ET AL.
		Examiner	**Art Unit**	
		FIRMN BACKER	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>19 November 2005</u> .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>12-36 and 39-63</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>12-36 and 39-63</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   This is in response to a Pre-Appeal brief filed on November 19ᵗʰ, 2005. In view of the

argument presented by the Applicant, examination hereby is reopened.

Response to Arguments

2.   Applicant's arguments with respect to claims 12-36, 39-63, have been considered but are

moot in view of the new ground(s) of rejection.

Claim Objections

3.   Claims 19-32 and 46-60 are objected to because of the following informalities: claim 19-

32 and 46-60, claim dependency on claim 3 and 37 which were previously canceled in the

application. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 12-36, 39-63 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by

Barnett et al (U.S. Patent No. 6,321,208).

6.   As per claim 12-14, 35-36, 39-41 and 61-63, Barnett et al teach an electronic commerce

system (*provided is a system for distributing and generating at a remote site product redemption*

coupons) comprising a client computer (*user's remote personal computer, 6*) and a server

computer (*online provider, 2*) (*see fig 1*) the client computer and the server computer being

interconnected by a public packet switched communications network (*internet*) (*see fig 1*) the

client computer being programmed to transmit to the server computer an order acceptance

request (*request for coupon*) comprising a plurality of terms or conditions of a proposed offer for

a purchase, the order acceptance request comprising a discrete message that includes at least one

of the modular elements (*coupon*) (*fig 5*) individually protected by a cryptographic security code

being a digital coupon (*the coupons 18 contain user-specific data in the form of a unique user*

bar code encoded with user-specific information such as the user name and/or other unique

identification criteria such as a social security number or online service address) (*see fig 1, 2, 5,*

column 7 lines 20-55), the server computer being programmed to process the order acceptance

request based on pre-programmed criteria including authentication and examination (*verifies the*

value of the redeemed coupons, determines the identification of users who redeemed the

coupons) of the cryptographic security codes embedded within each of the modular elements and

examination of the modular elements of the discrete message individually protected by the

cryptographic security codes (*unique user bar code encoded with user-specific information*),

and, based on the processing of the order acceptance request, to transmit to the client computer

an order acceptance response based on the pre-programmed criteria, the order acceptance

response comprising a discrete message transmitted during a negotiation phase of a transaction

that includes a plurality of modular elements whose individual integrity is protected by

embedding cryptographic security codes within each of the modular elements (*see fig 1, 2, 5,

column 7 lines 20-55*), wherein the client computer is programmed to receive the digital coupon,

protected by a cryptographic security code, from another computer (*coupon distributor, 16*) (see

fig 1).

7.   As per claim 13, 42, Barnett et al teach a system wherein the client computer is

programmed to provide information to the server computer concerning identify of the coupon

holder (*see fig 1, 2, 5, column 7 lines 20-55*).

8.   As per claim 14-18, 43-45, Barnett et al teach a system wherein the server computer is

programmed to authenticate authority of the client computer by virtue of a two-way-

authenticated SSL connection using a basic authentication method such as a client certificate (*see

fig 1*).

9.   As per claim 19, 46, Barnett et al teach a system wherein the digital coupon contains a

serial number to ensure that the digital coupon is used only once and the server computer is

programmed to determine whether the digital coupon has been used previously and to accept the

digital coupon only if it has not been used previously (*see fig 1, 2, 5, column 7 lines 20-55*).

10.   As per claim 20, 47, Barnett et al teach a system wherein the server computer is programmed to set at least one term of the order acceptance response based on whether the digital coupon is present in the order acceptance request (see fig 1, 2, 5, column 7 lines 20-55).

11.   As per claim 21, 48, Barnett et al teach a system wherein the at least one term of the order acceptance response is a price.

12.   As per claim 22-24, 49-51, Barnett et al teach a system wherein the server computer is programmed to set at least one term of the order acceptance response based on whether the digital coupon in the order acceptance request is a particular type of digital coupon (gift certificate comprises a serial number.

13.   As per claim 25, 52, Barnett et al teach a system wherein the server computer is programmed to ensure that the serial number has been used only once by checking a database in which the serial number is stored (see fig 1, 2, 5, column 7 lines 20-55).

14.   As per claim 26, 53, Barnett et al teach a system wherein the client computer is programmed to display an icon of the gift certificate and to initiate the order acceptance request after a recipient of the gift certificate clicks on the icon (see fig 1, 2, 5, column 7 lines 20-55).

15.   As per claim 27, 54, Barnett et al teach a system wherein further comprising a merchant

computer, the merchant computer being programmed to respond to the recipient clicking on the

icon by transmitting an order form to the client computer, the client computer being programmed

to initiate the order acceptance request when the recipient fills in the order form (*see fig 1*).

16.   As per claim 28, 55, Barnett et al teach a system wherein the client computer is a first

client computer programmed to receive the gift certificate from a second client computer (*see fig

1*).

17.   As per claim 29, 56, Barnett et al teach a system wherein the server computer is

programmed to transmit the gift certificate to the second client computer, which in turn is

programmed to forward the gift certificate to the first client computer (*see fig 1*).

18.   As per claim 30, 57, Barnett et al teach a system wherein the gift certificate comprises a

serial number and the server computer is programmed to create the serial number of the gift

certificate before transmitting the gift certificate to the second client computer (*see fig 1*).

19.   As per claim 31, 58, Barnett et al teach a system wherein the server computer is

programmed to store the serial number in a database before transmitting the gift certificate to the

second client computer, and is programmed, when it receives the gift certificate from the first

client computer to ensure that the serial number has been used only once by checking the

database in which the serial number is stored (*see fig 1, 2, 5, column 7 lines 20-55*).

20.   As per claim 32, 59, Barnett et al teach a system further comprising a merchant computer

programmed to transmit the gift certificate to the server computer before the server computer

transmits the gift certificate to the second client computer *(see fig 1)*.

21.   As per claim 33, 60, Barnett et al teach a system wherein the merchant computer is

programmed to transmit the gift certificate to the server computer in the form of an order

acceptance request that includes extension information indicating that the order acceptance

request is a gift certificate *(see fig 1, 2, 5, column 7 lines 20-55)*.

Examiner's note

22.   The Examiner has pointed out particular references contained in the prior art of record in

the body of this action for the convenience of the Applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claims, other passages and figures apply as well. It is requested from the Applicant, in

preparing the response, to consider fully the entire references as well as the context of all

passages in the cited references as potentially teaching all or part of the claimed inventions.
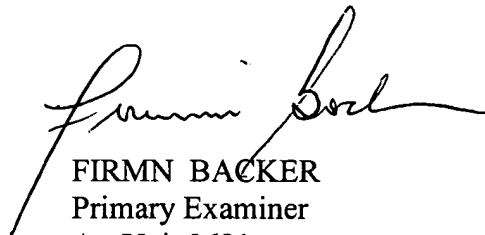
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMN BACKER whose telephone number is 571-272-6703. The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIRMN BACKER
Primary Examiner
Art Unit 3621

December 22, 2005